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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER				
ZURITA, JAMES II				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/827,392

Applicant(s)

STAW ET AL.

Examiner

JAMES ZURITA

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/19/2008 has been entered.

Response to Amendment

On 12/19/2008, applicant amended claims 1-10, 12-16 and 18-20.

Claims 1-23 are pending, of which claims 21-23 are withdrawn from prosecution as being directed to a non-elected invention.

Claims 1-20 will be examined.

Response to Arguments

Applicant's arguments filed 12/19/2008 have been fully considered but they are not persuasive.

Applicant has removed the term ...traditionally sold in pairs... except in claim 19.

Applicant argues:

New terms are often used when a new technology is in its infancy or is rapidly evolving. The requirements for clarity and precision must be balanced with the limitations of the language and the science. If the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the statute (35

U.S.C. 112, second paragraph) demands no more...This does not mean that the Examiner must accept the best effort of the applicant. If the proposed language is not considered as precise as a subject matter permits, the Examiner should provide reasons to support the conclusion of indefiniteness and is encouraged to suggest alternatives that are free from objection." MPEP 2173.05(a).

Read in light of the specification including tables and figures the terms traditional and nontraditional do reasonably apprise those skilled in the art, of the items traditionally sold as pairs.

In response to these arguments, the Examiner notes that applicant has not explained how the concept of ...traditionally sold in pairs... is a new term used when a new technology is in its infancy.

The Examiner also cites from MPEP 2173.05(a):

Courts have recognized that it is not only permissible, but often desirable, to use new terms that are frequently more precise in describing and defining the new invention. In re Fisher, 427 F.2d 833, 166 USPQ 18 (CCPA 1970). Although it is difficult to compare the claimed invention with the prior art when new terms are used that do not appear in the prior art, this does not make the new terms indefinite.

Applicant also argues

If the Examiner provides reasons to support the conclusion of indefiniteness and possibly suggest acceptable alternatives, applicant will address those reasons and suggestions.

The Examiner respectfully suggests removal of the term ...traditionally...

As to the rejection under 35 USC 102, applicant argues:

There is no disclosure by any of the cited prior art related to "selecting a minimum of one design feature on the items to be coordinated but not matched; creating a system to coordinate but not match the selected design feature on each item; and creating a minimum of two items with at least one coordinated design feature based on the system." Examiner states that Feld discloses that items are packaged for sale in quantities other than two. See, for example, Feld at least paragraph 0002 applicant does not find anything in Feld paragraph 0002, which discloses items packaged for sale in quantities other than two.

In response, Please see rejections under 35 USC 102 and 103.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the following terms refer to actions that are implied but not positively recited.

In claim 1's preamble, the term ...for coordinating but not matching design features of items...
In step 1.1, selecting, the term ...to be coordinated but not matched...
In step 1.2, selecting, the term ...on the items to be coordinated but not matched...
In step 1.3, creating a system ...to coordinate but not match...

The limitations refer to actions that take place outside the metes and bounds of the claim.

In Claim 1, the use of the term system renders the claim indefinite. In step 3, creating a system is interpreted as referring to creating a system [i.e., an undefined series of steps] and to creating a minimum of two items....based on the system [...i.e., the undefined series of steps of step 1.3]. In step 1.4, creating ... based on the system [undefined series of steps].

In claim 1, step 4, creating a minimum of two items is indefinite, since the items already exist, since the items are selected in previous limitations of the claim. The physical items are described in other claims as "...items...are...[socks, earrings, etc.]..."

The Examiner also notes that remaining claims pre-suppose the existence of the items that are initially selected, since applicant refers to the items as items chosen from a category of items traditionally sold in pairs.

For purposes of examination the limitations are interpreted to refer to one or more steps that are repeated to produce a result.

Coordinated, not-matched and their derivatives

In claim 1, the terms coordinated, not-matched [and their derivatives and combinations] are non functional descriptive material, merely describing inferential activities that are not involved in an active sense and are not positively recited. For example, Claim 1 refers, in part, to

selecting items [...label 1: to be coordinated but not matched];
selecting a feature on the items [...label 1: to be coordinated but not matched];
creating a system [a series of steps] [...label 2: to coordinate but not match] the selected feature on each item; and
creating a minimum of **two** [...label 3: coordinated...] **items** based on the [series of steps].

For purposes of examination the limitations are interpreted to refer to selecting items based on attributes.

...traditional sold in pairs...

In claims 19, the term ...traditionally sold in pairs... render the claims indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear how one determines what is *traditional* in order to avoid infringement. There is no mention of whose tradition is being addressed, which time period, century, country, for example.

In the absence of an explicit definition, ...traditionally sold in pairs... is given its broadest reasonable interpretation to include any aspect of cultural continuity in social

attitudes, customs, and institutions. MERRIAM WEBSTER Collegiate Dictionary. Prior art will be interpreted as reading on traditional, non-traditional where prior art discloses the action as occurring on any quantity of a product.

parts and pieces

Claim 8 refers to items with multiple parts. Claim 11 refers to products with multiple pieces. Claim 19 refers to products have multiple unconnected pieces and claim 20 refers to products that have multiple physically connected pieces. The specifications and drawings appear to use the terms parts and pieces as synonyms. The terms will be interpreted as synonyms.

Items and products

Claims 11, 19 and 20 refer to products, other claims refer to items. The specifications and drawings appear to use the terms as synonyms. The terms will be interpreted as synonyms.

Claims 2 and 3 refer to ...the system created to coordinate the selected design feature on each item... which is not previously introduced, since claim1 creates ...a system to coordinate but not match the selected design feature on each item...

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-6, 8-12, 14-16, 18-20, as interpreted, are rejected under 35U.S.C. 102(b) as being anticipated by Feld et al., US PG-PUB 20010026272, filed 26 February 2001 and published October 2001.

As per claim 1, Feld discloses method(s) for coordinating but not matching items comprising:

1.1 Selecting a minimum of one design feature on the items to be coordinated but not matched. See, for example, Feld, at least paragraph 0054.

1.2 Selecting a feature on the items to be coordinated but not matched. See, for example, Feld, at least paragraph 0045;

1.3 Creating a system to coordinate but not match the selected feature on each item. See, for example, Feld, at least Figs. 5, 6 and 10 for series of steps.

1.4 Creating a minimum of two items with at least one coordinated design feature based on the system. See, for example, Feld, paragraph 0012.

As per claim 2, Feld discloses that the series of steps considers criteria for coordination at least one of the following: considering age, sex and culture. Feld, paragraph 0032 and 0035.

As per claim 3, Feld discloses that the series of steps considers criteria for coordination of at least one of the following: the characteristics of color, patterns, shapes

and size for coordination. See, for example, Feld, at least color (paragraph 0039), patterns (paragraph 0013), shapes (paragraph 0002) and size (paragraph 0039).

As per claim 4, Feld discloses that items selected are chosen from a category of items sold in pairs. See, for example, Feld, socks, as in paragraph 0032).

As per claim 5, Feld discloses that the items selected are packaged for sale in quantities other than two. See, for example, Feld, at least paragraph 0002.

As per claim 6, Feld discloses that the items selected are socks. See, for example, Feld, at least paragraph 0032.

As per claim 8, Feld discloses that the items selected are chosen from a category of items with multiple parts. See, for example, Feld, at least eyeglasses, as in paragraph 0032; see also Fig. 11.

As per claim 9, Feld discloses that the items selected are eyeglasses. See, for example, Feld, at least paragraph 0032.

As per claim 10, Feld discloses that the items selected are sweatpants. See, for example, Feld, at least Paragraph 0032.

As per claim 11, Feld discloses that the items selected are chosen from a category of products with multiple pieces. See, for example, Feld, at least Fig. 11 and related text.

As per claim 12, Feld discloses the items selected are pajama tops, bottoms, and slippers. See, for example, Feld, at least Paragraph 0032, lingerie, underclothing.

As per claim 14, Feld discloses that the items selected are packaged for sale in a variety of different quantities. See, for example, Feld, at least paragraph 0002.

As per claim 15, Feld discloses that the items selected are chosen from a category of items matched within a group. See, for example, Feld, Fig. 1 and related text. See also paragraph 0054.

As per claim 16, Feld discloses that the items selected are items used in kitchens. See, for example, Feld, at least paragraphs 0008, 0032 and other references to furniture coverings, curtains, etc.

As per claim 18, Feld discloses that the items selected are packaged for sale in a variety of different quantities. See, for example, Feld, at least paragraph 0002.

As per claim 19, Feld discloses that items selected are chosen from a category of items traditionally sold in pairs wherein the products have multiple unconnected pieces. See, for example, Feld, at least paragraph 0032.

As per claim 20, Feld discloses that items selected are chosen from a category of items sold in pairs, wherein the products have multiple physically connected pieces. Feld, see, for example, at least Fig. 11 and related text.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 7, as interpreted, is rejected under 35 U.S.C. 103(a) as being unpatentable over Feld.

As per claim 7, Feld discloses does not specifically disclose that the items selected are earrings. Feld discloses that articles may include accessories such as

belts, jewelry. It would have been obvious to one of ordinary skill in the art at the time the invention was made to expand Feld to disclose that hat the items are earrings because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feld in view of Berger, US 6,414,693.

As per claim 13, Feld does not specifically disclose that the item selected is luggage. This is disclosed by Berger, Col. 1, lines 12-33. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Feld and Berger to disclose that a product is a luggage set because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feld in view of Marx et al. (PG-PUB 2003/0104148A1).

As per claim 17, Feld does not specifically disclose that the items selected are clothing items for members of a team. This is disclosed by Marx, paragraph 0008. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Feld and Marx to disclose that products are clothing for team members because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES ZURITA whose telephone number is (571)272-6766. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Zurita/
Primary Examiner
Art Unit 3625
19 January 2009